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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/421,635	10/19/1999	MARK A. REILEY	1759.16690	4414
26308	7590	07/28/2005	EXAMINER	
RYAN KROMHOLZ & MANION, S.C. POST OFFICE BOX 26618 MILWAUKEE, WI 53226			AHMED, AAMER S	
			ART UNIT	PAPER NUMBER
			3763	
DATE MAILED: 07/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/421,635

Applicant(s)

REILEY ET AL.

Examiner

Aamer S. Ahmed

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 57,65,69-71 and 81-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 57,65,69-71 and 81-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 57, 65 and 81 are rejected under 35 U.S.C. 102(b) as being anticipated by Strasser et al. (US 4,838,282 A). Strasser et al discloses a tool system comprising a trocar instrument (14) including a handle (16) with a finger gripping surface (16) that includes a recess (the space between elements 16.4) interrupting continuity of the finger gripping surface (16), a cannula instrument (12) including a bore (12.3) sized to accommodate the trocar instrument (14) to form a composite instrument, the cannula instrument (12) including a handle (18) with a finger gripping surface (18) that, when the composite instrument is formed, nests within the recess (the space between elements 16.4) to fill the interruption and form a continuous composite finger gripping surface (16, 18) for the composite instrument comprising the finger gripping surface (16) of the trocar instrument (14) resting in an adjacent and generally coplanar relationship with the finger gripping surface (18) of the cannula instrument (12) for grasping by a hand to transmit rotational and/or longitudinal force to the composite instrument sufficient to advance the composite instrument through tissue and/or bone, and wherein the composite handle (16, 18) is adapted, in use to receive a striking force. See Figures 2, 4, and 9. With respect to claim 65 see Column 5 lines 24-27.

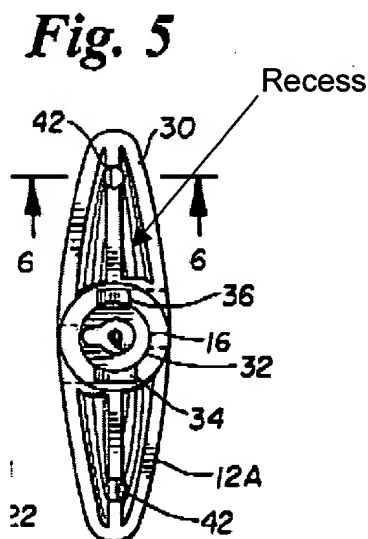
Claims 57 and 81 are rejected under 35 U.S.C. 102(b) as being anticipated by Scarfone et al. (US 5,385,151 A). Scarfone et al. discloses a tool system comprising a trocar instrument (20) including a handle (44) with a finger gripping surface (44) that includes a recess (see figure 3) interrupting continuity of the finger gripping surface (44), a cannula instrument (14) including a bore (24) sized to accommodate the trocar instrument (20) to form a composite instrument, the cannula instrument (14) including a handle (46) with a finger gripping surface (46) that, when the composite instrument is formed, nests within the recess (see figure 3) to fill the interruption and form a continuous composite finger gripping surface (44, 46) for the composite instrument comprising the finger gripping surface (44) of the trocar instrument (20) resting in an adjacent and generally coplanar relationship with the finger gripping surface (46) of the cannula instrument (14) for grasping by a hand to transmit rotational and/or longitudinal force to the composite instrument sufficient to advance the composite instrument through tissue and/or bone.



Jamshidi discloses a tool system comprising a trocar instrument (14) including a handle (12A) with a finger gripping surface (12A) that includes a recess (see figure 5) interrupting continuity of the finger gripping surface (12A), a cannula instrument (16) including a bore (27) sized to accommodate the trocar instrument (14) to form a composite instrument, the cannula instrument (16) including a handle (12B) with a finger gripping surface (12B) that, when the composite instrument is formed, nests within the recess (see figure 5) to fill the interruption and form a continuous composite finger gripping surface (12A, 12B) for the composite instrument comprising the finger gripping

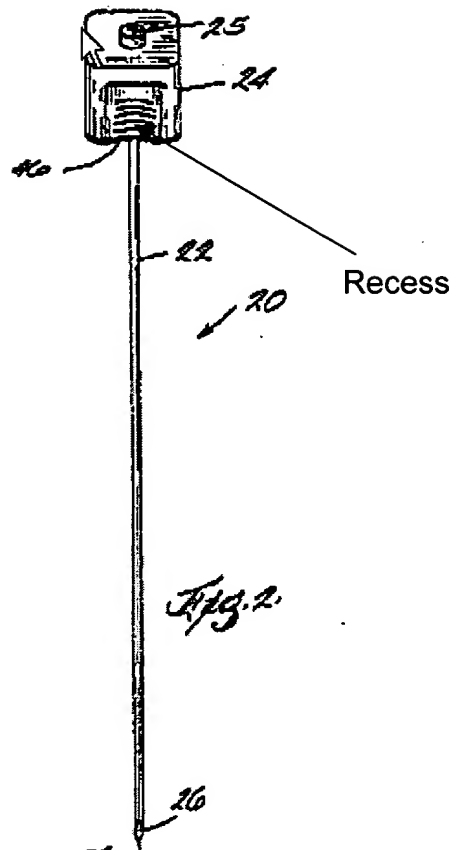
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surface (12A) of the trocar instrument (14) resting in an adjacent and generally coplanar relationship with the finger gripping surface (12B) of the cannula instrument (16) for grasping by a hand to transmit rotational and/or longitudinal force to the composite instrument sufficient to advance the composite instrument through tissue and/or bone, and wherein the finger gripping surface (12A) of the trocar instrument (14) includes a first securing element (42) in the recess, and wherein the finger gripping surface (12B) of the cannula instrument (16) includes a second securing element (40), sized and configured to engage the second securing element (40) when the composite instrument is formed to prevent independent rotation of the trocar (14) and cannula (16) instruments; and wherein at least one of the first (42) and second (40) securing elements includes a groove (42) and includes a key (42).



Claims 57 and 69-71 and 81-84 are rejected under 35 U.S.C. 102(b) as being anticipated by Byrne et al. (US 5,538,009 A)

Byrne discloses a tool system comprising a trocar instrument (22) including a handle (24) with a finger gripping surface (24) that includes a recess (see figure 2) interrupting continuity of the finger gripping surface (24), a cannula instrument (12) including a bore (30) sized to accommodate the trocar instrument (22) to form a composite instrument, the cannula instrument (12) including a handle (11,14) with a finger gripping surface (11,14) that, when the composite instrument is formed, nests within the recess (see figure 2) to fill the interruption and form a continuous composite finger gripping surface (24, and 11, 14) for the composite instrument comprising the finger gripping surface (24) of the trocar instrument (22) resting in an adjacent and generally coplanar relationship with the finger gripping surface (11,14) of the cannula instrument (12) for grasping by a hand to transmit rotational and/or longitudinal force to the composite instrument sufficient to advance the composite instrument through tissue and/or bone, and wherein the finger gripping surface (24) of the trocar instrument (22) includes a first securing element (46) in the recess (see figure 2), and wherein the finger gripping surface (24) of the cannula instrument (12) includes a second securing element (44, 48), sized and configured to engage the second securing element (46) when the composite instrument is formed to prevent independent rotation of the trocar (22) and cannula (12) instruments; and wherein at least one of the first (46) and second (44 48) securing elements includes a groove (46) and includes a key (44, 48).



Claims 57 and 69-71 and 81-84 are rejected under 35 U.S.C. 102(b) as being anticipated by Tretinyak (US 4,630,616 A).

Tretinyak discloses a tool system comprising a trocar instrument (14) including a handle (16) with a finger gripping surface (16) that includes a recess (16.4) interrupting continuity of the finger gripping surface (16), a cannula instrument (12) including a bore (12.3) sized to accommodate the trocar instrument (14) to form a composite instrument, the cannula instrument (12) including a handle (18) with a finger gripping surface (18)



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that, when the composite instrument is formed, nests within the recess (16.4) to fill the interruption and form a continuous composite finger gripping surface (16, 18) for the composite instrument comprising the finger gripping surface (16) of the trocar instrument (14) resting in an adjacent and generally coplanar relationship with the finger gripping surface (18) of the cannula instrument (12) for grasping by a hand to transmit rotational and/or longitudinal force to the composite instrument sufficient to advance the composite instrument through tissue and/or bone, and wherein the finger gripping surface (16) of the trocar instrument (14) includes a first securing element (16.3) in the recess (16.4), and wherein the finger gripping surface (18) of the cannula instrument (12) includes a second securing element (18.4, 18.5), sized and configured to engage the second securing element (18.4, 18.5) when the composite instrument is formed to prevent independent rotation of the trocar (14) and cannula (12) instruments; and wherein at least one of the first (16.3) and second (18.4, 18.5) securing elements includes a groove (16.3) and includes a key (18.4, 18.5).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 57, 65 and 81 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,575,919 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims are merely broader than the patented claims. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993), as the patented claims claim that the trocar is longer than the cannula, and the instant application claims do not; it would have been obvious to a person having ordinary skill in the art not to have this limitation.

### ***Response to Arguments***

Applicant's arguments filed March 3 2005 have been fully considered but they are not persuasive. Each of the above mentioned references describe finger gripping surfaces in which the ginger gripping surface comprises the finger gripping surface of the first functional instrument resting in an adjacent and generally coplanar relationship as viewed in the x axis with the finger gripping surface of the second functional instrument.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aamer S. Ahmed whose telephone number is 571-272-5965. The examiner can normally be reached on Monday thru Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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